

### **REMARKS/ARGUMENTS**

Claims 1-81 are presently pending and stand substantively rejected. Claims 14, 15, 37, 44, 49, 51, and 63 are presently amended. Reconsideration of the claims is respectfully requested. The paragraph numbering below follows that of the Office Action.

#### **Claim Amendments**

Support for the amendments to claims 14, 15, 37, 44, 49, 51, and 63 can be found in the specification at, for example, paragraphs [0139], [0266], and [0267]. No new matter is introduced.

#### **Double Patenting**

¶2. Claims 1-81 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-8 of co-pending Application No. 11/134,630 (Attorney Docket No. 018158-022250US). The provisional rejection is acknowledged.

#### **Rejection Under 35 U.S.C. §101**

¶4. Claims 14, 15, 37-51, and 63-64 were rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. This rejection is traversed.

Amended claims 14, 15, 37, 44, 49, 51, and 63 recite tangible media embodying machine-readable code. Withdrawal of this rejection is respectfully requested.

#### **First Rejection Under 35 U.S.C. §103**

¶6. Claims 1-72 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,724,258 to Roffman [“Roffman”]. This rejection is traversed.

According to MPEP 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to the artisan, to modify the reference. Further, the reference as modified must teach or suggest all claim elements. Roffman, even if modified as proposed by the Office Action, fails to meet this test.

#### **Independent Claim 1**

Presently pending independent claim 1 is drawn to a method for treating presbyopia of a patient that includes, among other things, measuring a first dimension of a pupil

at a first viewing distance, determining a first desired power for an eye at the first viewing distance, and determining a prescription for the eye for mitigating the presbyopia.

Advantageously, such techniques can provide improved prescriptions in the form of practical customized or optimized prescription shapes in a particular patient, as noted in the instant specification at paragraph [0012].

In contrast, Roffman discusses a neural network, trained with data from clinical evaluations of multiple individuals, that is used to predict lens designs for large populations of patients (see, e.g., Abstract). The clinical evaluations are not based on measurements from an individual patient for which the lens design is intended; this is not a customized approach for a particular patient. In fact, Roffman notes at col. 2, lines 42-48 that it is impractical to keep small inventories of a large variety of designs for small groups of patients, but instead it is more desirable to keep larger inventories of a smaller variety of designs for large groups of patients. Roffman's general approach for large populations is antithetical to the presently pending claim, which is drawn to a method for treating an individual based on aspects of the individual's ocular anatomy.

#### **Independent Claims 14, 16, 30, 36, 37, 51, 52, 63, and 65**

These presently pending independent claims are similar to current claim 1 in that they involve approaches for treating an individual based on the individual's ocular anatomy. For many of the reasons give above with respect to claim 1, Applicants respectfully submit that Roffman fails to render these claims obvious.

Claims 2-13, 15-29, 31-35, 38-50, 53-62, 64, and 66-72 depend directly or indirectly from the above noted claims, and are therefore allowable as depending from allowable base claims, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

#### **Second Rejection Under 35 U.S.C. §103**

¶10. Claims 73-81 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Roffman in view of U.S. Patent No. 6,808,266 to Youssefi ["Youssefi"]. This rejection is traversed.

According to MPEP 2143, to establish a *prima facie* case of obviousness, the references when combined must teach or suggest all claim elements. [expand test?] The combination of Roffman and Youssefi fails to meet this test.

#### **Dependent Claim 73**

Presently pending claim 73 is drawn to a method for treating presbyopia of an eye of a patient, based on pupil sizes of the patient's eye under certain viewing conditions. The method involves calculating a presbyopia-mitigating prescription, which includes determining a coefficient of a set of Zernike polynomials.

The Office Action at page 5 alleges that it would have been obvious to modify Roffman to calculate manifest refraction based on a Zernike model of wavefront as described by Youssefi. As noted above, Roffman involves designing a general lens for a large group of patients, based on clinical data from a group of individuals. Youssefi reports that optical aberrations can be described mathematically with Zernike polynomials. Thus, even if the Zernike model of Youssefi were combined with Roffman's approach as suggested by the Action, the result involve a general lens design based on a large sample of clinical Zernike polynomial data. The proposed combination would fail to provide a customized approach for treating an individual based on the individual's ocular anatomy.

Presently pending 74 depends from claim 73, and is allowable as depending from an allowable based claim, as well as for the nonobvious combination of elements it recites.

#### **Dependent Claims 75 and 76**

It is not clear why claims 75 and 76 were included in this rejection, as they do not recite a polynomial.

#### **Independent Claims 77, 78, 79, 80, and 81**

These presently pending independent claims are similar to current claim 73 in that they involve diagnostic and therapeutic approaches for an individual based on the individual's ocular anatomy. For many of the reasons give above with respect to claim 73, Applicants respectfully submit that the proposed combination of Roffman and Youssefi fails to render these claims obvious. It is not clear why claim 79 was included in this rejection, as it does not recite a polynomial.

Because the proposed combination of Roffman and Youssefi does not teach each and every element of presently pending claims 73-81, the test for a prima facie case of obviousness has not been met. Withdrawal of this rejection is respectfully requested.

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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